UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte PAUL L. MULLEN and MOHIT S. KATHURIA

_____

Appeal 2009-002253
Application 09/681,475
Technology Center 3700

_____

Decided: March 3, 2010

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Before JOHN A. JEFFERY, STEPHEN C. SIU, and JAMES R. HUGHES, *Administrative Patent Judges.*

SIU, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-34. We have jurisdiction under 35 U.S.C. § 6(b).

The Invention

The disclosed invention relates generally to equipment monitoring and administration (Spec. 1, ¶ [0001]).

Independent claim 1 is illustrative:

> 1.   A method for remotely managing an institution comprising the steps of:
> remotely collecting condition data representative of device status for a number of devices utilized in an institution, the condition data segregated into device diagnostic data and device reminder data;
> storing the condition data on a database at a centralized facility;
> reviewing the condition data to identify at least the device diagnostic data and the device reminder data; and
> separately displaying and identifying on a graphical user interface (GUI) the device diagnostic data and the device reminder data.

The References

The Examiner relies upon the following references as evidence in support of the rejections:

Wookey	US 6,182,249 B1	Jan. 30, 2001
Hansen	US 6,317,639 B1	Nov. 13, 2001
		(filed Jun. 08, 1999)

The Rejections

1. The Examiner rejects claims 1, 4, 7-9, 11-14, 16-19, and 22-34 under 35 U.S.C. § 102(b)[1] as being anticipated by Wookey.

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[1] Since Wookey issued less than a year before the filing date of the present application (April 13 2001), Wookey actually qualifies as prior art under §§ 102(a) and (e)—not § 102(b). We nevertheless deem this error harmless as

2. The Examiner rejects claims 2, 3, 5, 6, 10, 15, 20, and 21[2] under 35 U.S.C. § 103(a) as being unpatentable over Wookey and Hansen.

ISSUE

Appellants assert that Wookey "does not teach or suggest reminders" (App. Br. 7).

Did Appellants demonstrate that the Examiner erred in finding that Wookey discloses device reminder data?

FINDINGS OF FACT

The following Findings of Facts (FF) are shown by a preponderance of the evidence.

1. The Specification discloses that "a reminder item might include a reminder that a particular device is scheduled for preventive maintenance" (Spec. 16, ¶ [0043]).

2. The Specification discloses that reminders "might include . . . a newly received device or activated option has been scheduled and upcoming" (Spec. 16, ¶ [0043]).

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it does not affect our decision regarding the merits of the anticipation rejection.

[2] The Examiner rejects claim 20 under 35 U.S.C. § 103(a) as being unpatentable over Wookey and Hansen but rejects claim 21, which depends from claim 20, under 35 U.S.C. § 102(b) as being anticipated by Wookey. Since claim 21 depends from claim 20 and incorporates all limitations

3. The term "remind" is defined as to "to cause to remember" (*Websters New International Dictionary* (2nd ed., 1934)).

4. Wookey discloses "diagnostic capability which provides various types of system diagnostic information" (col. 1, ll. 30-32).

5. Wookey discloses that a support engineer remotely accesses a computer system (col. 1, ll. 38-39) and "can perform such tasks as analyzing hardware and software faults . . . analyzing messages file, checking configurations of add-on hardware" (col. 1, ll. 44-47).

6. Wookey discloses "a JAVA Graphical Users Interface (GUI) application to display the alerts in alert display 245" (col. 16, ll. 46-48) and a support engineering having "a number of options for displaying alerts" (col. 16, ll. 49-50).

7. Wookey discloses "a spot alert" that "indicates that a particular value of a system component has exceeded a threshold value" (col. 12, ll. 2-4).

8. Wookey discloses a "second type of alert" that is "a predictive alert" in which the alert "analyzes historical and current data to identify trends" (col. 12, ll. 14-17). In one example, "trend analysis identifies that the number of memory parity errors is increasing, even though the number is not yet fatal" (col. 12, ll. 21-23).

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recited in claim 20, we assume the Examiner rejects claim 21 under 35 U.S.C. § 103(a) as being unpatentable over Wookey and Hansen.

PRINCIPLES OF LAW

Statutory Subject Matter

Our reviewing court has recently held that transitory, propagating signals, such as carrier waves, are not within any of the four statutory categories (process, machine, manufacture or composition of matter). Therefore, a claim directed to computer instructions embodied in a signal is not statutory under 35 U.S.C. § 101. *In re Nuijten*, 500 F.3d 1346, 1357 (Fed. Cir. 2007).

35 U.S.C. § 102

In rejecting claims under 35 U.S.C. § 102, "[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation." *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005) (citation omitted).

Obviousness

The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966).

"The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 416 (2007).

ANALYSIS

As noted above, using a plain and ordinary meaning of the term "remind," a reminder includes anything that causes one to remember an event (FF 3). Also as described above, the Specification discloses that a reminder may remind an individual of a scheduled option or event (FF 1-2).

Wookey discloses information regarding the diagnostics of a device (FF 4) or "a spot alert" alert that informs a state of a device (e.g., that a particular value of a component has exceeded a threshold value) (FF 7). Wookey also discloses "a second type of alert" that uses trend analysis to identify and alert a user to device status such as reporting that the number of memory parity errors of a device is increasing (FF 8). The diagnostic information and the "spot alert" of Wookey inform a user of the particular status of a device and the "second type of alert" of Wookey reports ongoing trends in changes in status of the device. None of this information appears to cause the user to remember a scheduled event (i.e., reminder data). Therefore, the Examiner has not demonstrated and we do not find that any of this information of Wookey constitutes "reminder data" as recited in claim 1.

The Examiner finds that "Wookey discloses an alert system that indicated predefined conditions existed in a computer system" and that [s]ince the condition is preset in the disclosure of Wookey then the alert system of Wookey can be used as a reminder system as claimed" (Ans. 6). However, the Examiner does not indicate where in the reference Wookey

supposedly discloses alerts to "predefined conditions." Nor do we independently identify such a disclosure in the Wookey reference.

Independent claims 9 and 17 recite similar features as recited in claim 1. We therefore reverse the Examiner's rejection of these claims for similar reasons. Regarding independent claim 25, we agree with Appellants (App. Br. 8-9) that the Examiner has simply failed to address the distinctions between this claim and claim 1, let alone explain how Wookey anticipates the unique limitations of claim 25. The Examiner's rejection is therefore deficient for this additional reason.

Accordingly, we conclude that the Examiner erred in rejecting independent claims 1, 9, 17, and 25, and claims 2-8, 10-16, 18-24, and 26-34, which depend therefrom.

New Ground of Rejection -- 37 C.F.R. § 41.50(b)

Using our authority under 37 C.F.R. § 41.50(b), we reject claims 25-31 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Claims 25-31 are drawn to a computer data signal embodied in a carrier wave. However, signals, such as carrier waves, are not within a statutory category of patentable subject matter. *Nuijten*, 500 F.3d at 1357. As such, claims 25-31 are drawn to subject matter (i.e., computer instructions embodied in a signal) that is not statutory under 35 U.S.C. § 101.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that
Appellants have demonstrated that the Examiner erred in finding that
Wookey discloses device reminder data. However, we reject claims 25-31
under 35 U.S.C. § 101 as being drawn to non-statutory subject matter.

DECISION

We reverse the Examiner's decision rejecting claims 1, 4, 7-9, 11-14,
16-19, and 22-34 under 35 U.S.C. § 102(b) and claims 2, 3, 5, 6, 10, 15, 20,
and 21 under 35 U.S.C. § 103.

In a new ground of rejection, we have rejected claims 25-31 under 35
U.S.C. § 101 as being drawn to non-statutory subject matter using our
authority under 37 C.F.R. § 41.50(b).

37 C.F.R. § 41.50(b) provides that "[a] new ground of rejection
pursuant to this paragraph shall not be considered final for judicial review."
37 C.F.R. § 41.50(b) also provides that Appellant, <u>WITHIN TWO
MONTHS FROM THE DATE OF THE DECISION</u>, must exercise one of
the following two options with respect to the new ground of rejection to
avoid termination of the appeal as to the rejected claims:

> (1) *Reopen prosecution.* Submit an appropriate
> amendment of the claims so rejected or new evidence relating
> to the claims so rejected, or both, and have the matter
> reconsidered by the examiner, in which event the proceeding
> will be remanded to the examiner. . . .

> (2) *Request rehearing.* Request that the proceeding be
> reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

<u>REVERSED</u>
<u>37 C.F.R. § 41.50(b)</u>

msc

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